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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/798,366

03/12/2004

Stanislav M. Snair

000417.00018

6070

22907 7590 11/26/2008

BANNER & WITCOFF, LTD.

1100 13th STREET, N.W.

SUITE 1200

WASHINGTON, DC 20005-4051

EXAMINER

LOPEZ, CARLOS N

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

11/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

APPENDIX A

Applicant's arguments filed 11/10/08 have been fully considered but they are not persuasive. Applicant argues that "combustible" is defined as a material that will burn and ash when the cigarette is smoke, contrast with "non-combustible" as material that will not burn or ash when the cigarette is smoked. Applicant then argues that based on the said definitions, the applied references fail to show the claimed limitation of "combustible."

MPEP at 2111 provides that: The ordinary and customary meaning of a term may be evidenced by a variety of sources, including "the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art."

Here, applicant is placing an added limitation to the terms "combustible" and "non-combustible" by distinguishing both terms based on whether or not the material burns and ashes at the temperature at which the cigarette is smoked. Consequently, applicant is adding more limitations to a claim that merely requires a material to be "combustible." Applicant uses the words used in another patent and the words in his claims to arrive at the conclusion that "non-combustible" and "combustible" are mutually exclusive. However, as provided MPEP citation above, the meaning of the word "combustible" should be evidence by "the words **of the claims themselves**, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of

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the art.” Here, applicant is not relying on “the words of the claims themselves” but rather between another patent and the words of the instant claims.

In regards to the declaration, MPEP 716.01 provides:

Evidence traversing rejections must be timely or seasonably filed to be entered and entitled to consideration. In re Rothermel, 276 F.2d 393, 125 USPQ 328 (CCPA 1960). Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted:

- (1) prior to a final rejection,
- (2) before appeal in an application not having a final rejection, *
- (3) after final rejection , but before or on the same date of filing an appeal, **upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e);** or
- (4) after the prosecution is closed (e.g., after a final rejection, after appeal, or after allowance) if applicant files the affidavit or other evidence with a request for continued examination (RCE) under 37 CFR 1.114 in a utility or plant application filed on or after June 8, 1995; or a continued prosecution application (CPA) under 37 CFR 1.53(d) in a design application.

As noted in the bold text above, applicant has not shown a “**good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e).**” Therefore the declaration is not timely and will not be considered.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARLOS LOPEZ whose telephone number is (571)272-1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carlos Lopez/
Primary Examiner
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